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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,247	12/19/2001	Robert D. Covington	635482.625.036	8138

7590 06/05/2006  
Ronald A. Sandler  
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77 West Wacker Drive  
Chicago, IL 60601-1692

EXAMINER
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POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/026,247	<b>Applicant(s)</b> COVINGTON ET AL.	
	<b>Examiner</b> Robert M. Pond	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9,12,13,15-28,32-34,36-39,42-49,51-54,58-61,65 and 67-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,12,13,15-28,32-34,36-39,42-49,51-54,58-61,65 and 67-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 February 2006 has been entered.

### ***Response to Amendment***

The Applicant amended claims 1, 26, 36, 37, 46, and 58. All pending claims (1-6, 8, 9, 12, 13, 15-28, 32-34, 36-39, 42-49, 51-54, 58-61, 65, and 67-69) were examined in this non-final office action.

### ***Response to Arguments***

#### **Regarding Rejection under 35 USC 103(a)**

Applicant's arguments filed 28 February 2006 have been fully considered but they are not persuasive. The cited prior art clearly discloses, teaches, and suggests wish lists being transmitted and viewed by individuals other than the wish list registrant. Language added to the independent claims pertaining to a

concierge service does not distinguish over the prior art. A concierge service is just another buyer that can receive the wish list info.

Though not relied upon, the Examiner is offering examples of prior art pertaining to concierge services and shopping:

- Habib, Marlene; "Luxuary goods are big hit in pre-Christmas shopping, » The Vancouver Sun, 13 December 1997, Proquest #642053541, 3pgs; teaches internet web shopping malls; Sherway mall providing a concierge service using a computer for gift suggestions.
- Hoover, Barbara; "Special delivery: Grocers come out of the aisle and into the streets for customers," The Detroit News, 21 January 1997, Proquest #10892493, 2pgs; teaches home delivery services being a common service decades ago; using a shopping list (i.e. a wish list), receiving home delivery of food items that were plucked from the store shelves, bagged, and delivered.
- Correa, Tracy; "Shopping without shopping, shopping goes to a personal level \*Busy execs find personal buyer program a real time-saver," The Fresno Bee, 23 December 1997, Proquest #44785387, 4pgs; teaches a personal shopper at the Macys store in Fashion Fair Shopping Center, using an executive's list of items to make purchase selection on behalf of the executive.

Art Unit: 3625

- Machlis, Sharon; "Putting in-store service online," Computerworld, 02 November 1998, v32i44pg14, Proquest #35611688, 3pgs; teaches Nordstrom offering a personal shopper program; using email to communicate a shopping list to the personal shopper.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-6, 8, 9, 12, 13, 15, 19-21, 24-28, 32-34, 37-39, 42-44, 46-49, 51-54, 58-61, 65, and 67-69 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), in view of Robertson (Paper #20041223, US 6,609,106), further in view of Business Wire (PTO-892, Item: U) and Official Notice (Paper #20041223, admitted regarding well within the skill hereinafter referred to as "ON1").**

LeRoy teaches a system and method of shopping in a physical retail location and online, creating a wish list by a registrant who may either scan product selections while physically in a store or create the wish list online (e.g. from home), and customers making actual purchases on behalf of the registrant based

on the registered wish list (see at least abstract; col. 1, line 13 through col. 2, line 10). LeRoy further teaches:

- Providing a database and a handheld data entry unit including internal memory; Database coupled to a computer server: (see at least Fig. 1 (15, 30); col. 3, lines 23-34; col. 4, line 62; col. 7, lines 35-57).
- Storing item information (in handheld unit memory; Handheld unit with internal memory to scan physical items: (see at least col. 5, lines 52-55).
- Uploading lists from the internal memory of the handheld unit to the database: (see at least Fig. 1 (15); col. 6, lines 39-67).
- Creating a wish list of items; storing wish list in database: registrant selects desired items (please note examiner's interpretation: creating a list of desired items is a wish list); associates scanned items with registry ID; registrant login requiring username and password (see at least Fig. 2 (R2); col. 2, lines 19-22; col. 7, lines 42-44 col. 9, lines 53-61).
- Identifying retailer: retailer code associated with stock number (see at least col. 7, lines 61-66).
- Providing a web site that allows a buyer to search for an view the wish list: registrant uses a web site to create one or more wish lists (please note examiner's interpretation: the registrant creates one or more lists of desired items to be purchased by others (e.g. wedding, birthday). The mere act of exposing the wish list to others via the gift registry system converts the wish list into a buy list from the perspective of others viewing

the information who want to use the list to buy one or more items for the registrant) (see at least col. 1, lines 14-17; col. 6, lines 27-33). Please note: a concierge is another type of buyer.

- Associating a member with scanned items: customer (please note: "member" is defined by Applicant as a buyer) scans items on a registrant's wish list (see at least col. 5, line 10 through col. 6, line 67).

LeRoy teaches all the above as noted under the 103(a) rejection and teaches a) a registrant creating and storing a wish list in an online gift registry, b) buyers purchasing items online on behalf of a registrant from a list stored in the online gift registry, and c) extensive use of communication and computer technology to help a registrant create a buy list for buyers to use on behalf of the registrant, but does not specifically disclose creating an access mechanism that notifies selected buyers of the existence of one or more of the wish list. Robertson teaches an online gift registry and notification method to registrants and buyers, registrants creating wish lists and buyer distribution lists used to route email messages to the registrant's buyers, and distribution based on events (see at least abstract; Fig. 1, 40, 50, 60, 70); Fig. 20a-c; Fig. 25 (400); Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to include transmitting a message to a buyer listed in a distribution list based on an event

as taught by Robertson, in order for a buyer to be made aware that buy lists exists for events, and thereby attract buyers to the online gift registry service.

LeRoy teaches all the above as noted under the 103(a) rejection but does not disclose associating a plurality of member identification numbers with one registered user. Robertson teaches the registrant creating a distribution list containing a plurality of individuals associated with the registrant, and using email to notifying each individual on a distribution list (please note examiner's interpretation: email address of each individual on the distribution list represents a number that identifies the individual) (see at least Fig. 27 (475); col. 22, lines 14-19). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of LeRoy to implement a distribution list containing individuals associated with a registrant as taught by Robertson, in order to associate a plurality of individuals with a user who would be interested in the user's wish list, and thereby generate sales for the online service.

LeRoy and Robertson teach all the above as noted under the 103(a) rejection and teach a) registrant password usage by the registrant, and b) the registrant marking wish list items as private or not marking as private for public viewing (Robertson: see at least Fig. 31; col. 5, lines 35-38), but do not disclose use of a password for access by buyers. Business Wire teaches an online site featuring a private-multi-member environment for families to gather, facilitate personal relationships, shop, and share information (e.g. gift registry) on the Internet using a password-protected site so that only members invited by the registrant are



allowed to access the registrant's site (U: see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of LeRoy and Robertson to implement password protected access by buyers to a registrant's site as taught by Business Wire, in order to facilitate personal relationships, and thereby attract registrants to the online service.

LeRoy, Robertson, and Business Wire teach all the above as noted under the 103(a) rejection and teach a) scanning items with a portable scanner in the physical retailer that stores registrant gift registry selections in the portable scanner, and b) registrants physically moving about a store to make selections, but do not disclose registering after scanning items. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy, Robertson, and Business Wire to disclose registering after scanning, since it is well within the skill to ascertain that accepted retail business practices allow potential gift registry registrants to physically collect item information in a store prior to registering, in order to allow a potential registrant an opportunity to determine whether the retailer's goods are suitable to the potential registrant's wish list.

2. **Claim 16 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), Robertson (Paper #20041223, US 6,609,106), and Business Wire (PTO-892, Item: U) and ON1 (Paper**

**#20041223, admitted regarding well within the skill), as applied to claim 15, further in view of Schwartz et al. (Paper #20041223, US 5,913,032 hereinafter referred to as "Schwartz").**

LeRoy, Robertson, and Business Wire and ON1 teach all the above as noted under the 103(a) rejection and teach sending emails to buyers on a distribution list, but do not disclose choosing buyers from an address book. Schwartz teaches electronic address books as simplifying the email process, and further teaches choosing email recipients from an address book to populate distribution lists (see at least abstract; col. 13, line 32 through col. 14, line 33). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy, Robertson, and Business Wire and ON1 to choose email recipients from an address book as taught by Schwartz, in order to simplify email processing by the registrant, and thereby attract registrants to the service.

3. **Claims 17, 36, and 45 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), Robertson (Paper #20041223, US 6,609,106), and Business Wire (PTO-892, Item: U) and ON1 (Paper #20041223, admitted regarding well within the skill), as applied to claims 15, 26, and 44, further in view of Official Notice (Paper #20041223, admitted regarding well within the skill hereinafter referred to as "ON4").**

LeRoy, Robertson, and Business Wire and ON1 teach all the above as noted under the 103(a) rejection and teach or suggest a) issuing an email notification to

the user including a embedded link that takes the user directly to preferred web site (please note: a hyperlink) (see at least Fig. 7 (190); col. 15, lines 19-25), b) issuing an email to a buyer on a user's distribution list, and c) requiring a buyer to use a password to access a private wish list, but do not disclose embedding the password in a hyperlink. It would have been obvious to one of ordinary skill in the art at time of the invention to modify LeRoy, Robertson, and Business Wire and ON1 to disclose embedding the password in a hyperlink, since it is well within the skill to ascertain the service wants the notified buyer to go directly to the user's wish list in order to make a purchase from the wish list, and thereby provide the buyer a shopping convenience.

- 4. Claim 18 is rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), Robertson (Paper #20041223, US 6,609,106), and Business Wire (PTO-892, Item: U) and ON1 (Paper #20041223, admitted regarding well within the skill), as applied to claim 1, further in view of Wireless Data News (Paper #20041223, PTO-892, Item: U hereinafter referred to as "WDA").**

LeRoy, Robertson, and Business Wire and ON1 teach all the above as noted under the 103(a) rejection and teach wireless scanning of items, but do not disclose other input devices comprising a wireless telephone and a personal digital assistant. WDA teaches a) a wireless handheld scanning terminal, b) the Wireless Application Protocol (WAP) used for mobile communications and

accessing Internet services using cellular phones, and c) a handheld computing device (e.g. palm-size device with keyboard and screen to help deaf or hard-of-hearing users communicate interactively) (please note examiner's interpretation: a PDA providing the user a computing convenience) (U: see at least pages 1 and 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of LeRoy, Robertson, and Business Wire and ON1 to provide a group of input devices as taught by WDA, in order to accommodate a variety of input devices, and thereby provide a shopping convenience.

- 5. Claims 22 and 23 are rejected under 35 USC 103(a) as being unpatentable over LeRoy (Paper #20041223, US 5,970,474), Robertson (Paper #20041223, US 6,609,106), and Business Wire (PTO-892, Item: U) and ON1 (Paper #20041223, admitted regarding well within the skill), as applied to claim 1, further in view of Official Notice (#20041223, admitted regarding well within the skill hereinafter referred to as "ON5").**

LeRoy, Robertson, and Business Wire and ON1 teach all the above as noted under the 103(a) rejection and teach a) retailers providing merchandise for gift registry buyers, b) organizing wish lists by events (e.g. birthdays), and c) using icon tabs to organized information by events, but do not specifically disclose wish lists organized by specific retailers. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of LeRoy, Robertson,

and Business Wire and ON1 to organize wish lists by specific retailers, since it is well within the skill to ascertain that specific retailers promote events with special pricing (e.g. Washington/Lincoln's birthday), and thereby provide incentives to organize wish lists based on specific retailers.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Habib, Marlene; "Luxuary goods are big hit in pre-Christmas shopping, » The Vancouver Sun, 13 December 1997, Proquest #642053541, 3pgs; teaches internet web shopping malls; Sherway mall providing a concierge service using a computer for gift suggestions.
- Hoover, Barbara; "Special delivery: Grocers come out of the aisle and into the streets for customers," The Detroit News, 21 January 1997, Proquest #10892493, 2pgs; teaches home delivery services being a common service decades ago; using a shopping list (i.e. a wish list), receiving home delivery of food items that were plucked from the store shelves, bagged, and delivered.
- Correa, Tracy; "Shopping without shopping, shopping goes to a personal level \*Busy execs find personal buyer program a real time-saver," The Fresno Bee, 23 December 1997, Proquest #44785387, 4pgs; teaches a personal shopper at the Macys store in Fashion Fair Shopping Center, using an executive's list of items to make purchase selection on behalf of the executive.
- Machlis; "Putting in-store service online," Computerworld, 02 November 1998, v32i44pg14, Proquest #35611688, 3pgs; teaches

Nordstrom offering a personal shopper program; using email to communicate a shopping list to the personal shopper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. M. Pond', written in a cursive style.

Robert M. Pond  
Primary Examiner  
May 10, 2006